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UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

17 GREGORY RICKS,

Case No. 2:08-cv-01174-PMP-GWF

18 Plaintiff,

19 v.

20 BMEzine.COM, LLC,

21 Defendant.

**AMENDED COUNTERCLAIM FOR
DAMAGES, INJUNCTIVE, AND
DECLARATORY RELIEF**

23 BMEzine.COM, LLC,

- (1) Cybersquatting under 15 U.S.C. § 1125(d)
- (2) Trademark Infringement under 15 U.S.C. § 1125(a)
- (3) Willful Trademark Infringement under 15 U.S.C. § 1114(1)
- (4) False Designation of Origin under 15 U.S.C. § 1125(a)
- (5) Unfair Competition under 15 U.S.C. § 1125(a)

24 Counterclaim Plaintiff,

25 v.

27 GREGORY RICKS, and
GEE WHIZ DOMAINS, INC.

28 Counterclaim Defendant.

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- (6) Nevada Common Law Trademark Infringement
- (7) Deceptive Trade Practices under N.R.S. 598.0903, *et seq.*
- (8) Intentional Interference with Prospective Economic Advantage
- (9) Trademark Infringement under Fla. Stat. § 495.131
- (10) Dilution under Fla. Stat. § 495.151

Defendant/Counter Plaintiff, BMEzine.COM, LLC ("Defendant" or "BME") by and through its attorney of record, the law firm of Greenberg Traurig, LLP, hereby files its Amended Counterclaim against Plaintiff/Counter Defendant Gregory Ricks ("Ricks") and Counterclaim Defendant Gee Whiz Domains, Inc. ("Gee Whiz"), and alleges as follows:

I. INTRODUCTION

1. This action seeks declaratory relief, injunctive relief, and damages against Ricks' willful infringement and dilution of BME's famous trademark "BME" (hereinafter the "BME mark") resulting from Ricks' use of the BME tradename, service mark, and <bme.com> and <bme.us> Internet domain names in violation of 15 U.S.C. §§ 1051 *et seq.* (the "Lanham Act"), the Anti-cybersquatting Consumer Protection Act ("ACPA") (15 U.S.C. § 1125(d)), N.R.S. 598.0903 *et. seq.*, the Florida Dilution Act, *Fla. Stat. § 495.151*, Florida trademark infringement as under *Fla. Stat. § 495.131*, Florida's Unfair and Deceptive Trade Practices Act, and the common law doctrines of unfair competition, trademark infringement and intentional interference with prospective economic advantage.

II. JURISDICTION AND VENUE

2. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202, and supplemental jurisdiction over the state law claims pursuant to 28 U.S.C. §§ 1338(b) and 1367.

3. Venue currently lies in this district, by virtue of the fact that Ricks has filed an original action in this district and this Complaint is brought as a compulsory Counterclaim.

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III. THE PARTIES

4. BME is a Nevada limited liability company with its principal place of business in Toronto, Canada.

5. BME is the most well-known body art specialty publisher in the world.

6. BME operates a network of websites, all of which provide services of interest to the body art community and marketplace.

7. Ricks is the registered name holder of the <bme.com> and <bme.us> Internet domain names (the "Infringing Domain Names").

8. Ricks, upon information and belief, is in the business of cybersquatting on famous trademarks in order to earn pay-per-click fees or other advertising revenue from trading on the fame of the marks.

9. An inspection of Ricks' domain name portfolio reveals many domain names that are infringing upon both registered and common-law trademark rights of third parties.

10. Upon information and belief, Ricks is either the principal or alter ego of Gee Whiz Domains, which is additionally in the business of cybersquatting on famous trademarks. In fact, Gee Whiz Domains is the registrant of the following domains which infringe upon the intellectual property rights of third parties: <machtcom.com>, <yahooemai.com>, <msnnb.com>, <billgates.com>, <newyorktimesbestseller.com>, <microsoet.com>, <microsotcom.com>, <xmrasdio.com>, <lufthamsa.com>, <microsoftclipart.com>, <ultimatesurrenderpassword.com>, <epinione.com>, <exxonmobill.com>, <barbizioni.com>, <googlepagescreator.com>, <cnnmmoney.com>, <toysru.com>, <yahoeee.com>, <htpgmail.com>, <officedepo.com>, <cartmax.com>, <snoopdog.com>, and <napsterlite.com>.

11. Moniker.com, a Florida corporation, is the registrar of the domain names <bme.com> and <bme.us.>

12. Pursuant to 15 U.S.C. § 1125(d)(1)(c), this Court is empowered to order the Registrar to transfer the Infringing Domain Names to a prevailing Plaintiff.

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IV. BACKGROUND

A. BMEzine's Valuable Common-Law Trademark Rights

13. BME has been using the BME mark in international commerce in connection with tattooing and piercing journalism since as early as 1994, when it was used regularly on an Internet newsgroup, and as such, its use pre-dates the World Wide Web. See Exhibit A, and Composite Exhibit B.

14. BME holds a valid U.S. trademark registration, Registration No. 3579098 for:

- Providing an online interactive database of photos and videos in the field of body art, namely, piercing, tattoos, scarification, subincision, castration; and
- Providing news about body art, namely, piercing, tattoos, scarification, subincision, castration through photos and videos.

15. BME owns overwhelming common law trademark rights in the BME mark established by fourteen (14) years of continuous and widespread use on the Internet, millions of daily visitors to the BME network of websites, as well as near ubiquitous recognition in the relevant channels of trade.

16. BME has been using "BME" as a source identifier for its services since 1994. The use of "BME" ("Body Modification 'Ezine") has spanned across the Internet; the website has been viewed in all countries, "BME" has been featured in numerous tattoo, body modification and mainstream print articles; and is clearly recognizable to anyone in the relevant marketplace and well beyond. See Exhibits A, B, and C.

17. The BME mark has achieved strong secondary meaning in both the mainstream press and in the relevant marketplace. "BME" is a famous mark, especially within the body art, tattooing, and piercing communities. See Declarations of Kevin Wimberly, Exhibit D, Elayne Angel, Exhibit E, and Allen Falkner, Exhibit F. See also Exhibits A, B, and C.

18. Additionally, acquired distinctiveness of this mark is apparent from the evidence attached in Composite Exhibit G to this Complaint. See also Exhibits A and B. This evidence consists of a representative sampling of unsolicited media attention

1 bestowed upon BME. As shown in these Exhibits, BME is frequently mentioned in the
2 mainstream media on a regular basis.

3 19. Further evidence of the BME common law rights exists on Wikipedia.com.
4 See http://en.wikipedia.org/wiki/BME_%28website%29 and Exhibit H. While "facts"
5 reported on Wikipedia are hardly conclusive evidence, as it may be edited by anyone at
6 any time, the Wikipedia history shows that there has been a Wiki on BME since April of
7 2004, and that it has been edited many times by many users. See Exhibit I.

8 20. In 1995, "BME" won a Lydia Award for best World Wide Web site and Best
9 Body Art Magazine (any medium) See Exhibit J.

10 21. BME is frequently mentioned in other sources of Body Art media. See
11 Exhibits A, B, and G, which detail unsolicited media attention focused on BME from 1994 to
12 1998.

13 22. In July of 1998, Playgirl Magazine noted that BME is "a good place to learn
14 about genital piercing!" See Playgirl Magazine, July 1998 at p. 42.

15 23. BME's flagship website, BMEZine.com, is linked to by 1,216 other websites.
16 See Exhibit K.

17 24. The BME mark (in connection with the body art, tattooing, and piercing
18 industry) can only identify BME, and Internet users who navigate their browsers to the
19 Infringing Domain Name would be misled to believe that the Infringing Domain Name (a
20 true and correct copy of the website BME.com as of the date the UDRP Complaint was
21 filed appears at Exhibit L) is in some way connected to or affiliated with BME.

22 25. This misuse of the BME mark created confusion between BME's and Ricks'
23 domains, as shown in Exhibit M. See also Expert Witness Declarations, Exhibits D-F.
24 Given the fact that BME only does business online, this could create a crisis in the
25 marketplace.

26 26. In 1994, BME's publication was launched on Usenet, and later on
27 BME.freeq.com. See Composite Exhibit N, which consists of historical printouts of
28 bme.freeq.com. Thereafter, BME has done business on a collection of websites on the

1 World Wide Web, as discussed below. BME operates, among others, the following
2 websites, printouts of which are attached hereto as Composite Exhibit O:

- 3 a. BMEfest.com a website that promotes the annual
4 gathering for members of the community of the BME family of
5 websites;
- 6 b. BMEvideo.com, an adult site displaying online videos of
7 extreme and erotic body modification (graphic portions
8 redacted);
- 9 c. BMEhard.com, a site that allows users to post content on
10 bonus galleries;
- 11 d. BMEboys.com, a blog-type site that allows user posted
12 pictures and text;
- 13 e. TeamBME.com, a mailserver site which provides email
14 accounts for members of "Team BME" (people with BME
15 tattoos);
- 16 f. AskBME.com, a question and answer site for members of
17 the body art, tattooing, and piercing community;
- 18 g. BMEworld.com, a site offering free homepages and
19 anonymous e-mail for members of the body modification
20 community;
- 21 h. BMEink.com, a site designed to give the tattoo-specific
22 members of the BME community a separate forum;
- 23 i. BMEzine.com, BME's flagship site;
- 24 j. BMEjapan.com, a site designed for Japanese-speaking
25 members of the body modification community;
- 26 k. BMEscholarship.com, a website that accepts donations
27 to provide academic scholarships to members of the body
modification community;
- 28 l. BMEshop.com, a website that sells merchandise specific
29 to the body art, tattooing, and piercing community;

27. BME has created a genuine commodity in the BME mark.

1 28. The BME mark was famous and/or distinctive at least as early as the date
2 that Ricks registered the Infringing Domain Names.

3 29. Allen Falkner and Elayne Angel are experts in the fields of Body Piercing and
4 Body Art. They confirm the obvious – that the mark BME can only identify BME, and any
5 other use of the mark will result in a strong likelihood of confusion in the relevant
6 marketplace. See Declarations of Angel and Falkner, attached as Exhibits E, and F. See
7 also, Declaration of Kevin Wimberly, at Exhibit D.

8 **B. Ricks' Wrongful Conduct**

9 30. On or about June 15, 2008, Ricks registered the Infringing Domain Name,
10 <bme.com>, with Moniker Online Services, Inc., a registrar for domain names. The
11 Infringing Domain Name contains the entirety of BME's distinctive mark.

12 31. On or about August 30, 2008, Gee Whiz registered the Infringing Domain
13 Name, <bme.us,> with Moniker Online Services, Inc., a registrar for domain names. The
14 Infringing Domain Names <bme.us> contains the entirety of BME's distinctive mark.

15 32. Upon information and belief, Ricks and Gee Whiz registered the Infringing
16 Domain Names as a direct result of the popularity of BMEzine's online services offered in
17 connection with the BME mark.

18 33. The registration of <bme.com> was made after Ricks had actual knowledge
19 of BME and BME's common-law trademark rights.

20 34. Even if Ricks registered the <bme.com> domain name without bad faith,
21 Ricks later used <bme.com> in a bad faith intent to profit from confusion with BME's marks.

22 35. Upon information and belief, Ricks chose to register and/or use <bme.com>
23 and commenced use of the BME mark in connection with his website solely for the purpose
24 of improperly trading upon BME's trademark rights, or for the purpose of attempting to re-
25 sell the domain to BME.

26 36. The registration of <bme.us> was made after Gee Whiz had actual
27 knowledge of BME and BME's common-law trademark rights.

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1 37. Even if Gee Whiz registered the <bme.us> domain name without bad faith,
2 Gee Whiz later used <bme.us> in a bad faith intent to profit from confusion with BME's
3 marks.

4 38. Upon information and belief, Gee Whiz chose to register and/or use
5 <bme.us> and commenced use of the BME mark in connection with his website solely for
6 the purpose of improperly trading upon BME's trademark rights, or for the purpose of
7 attempting to re-sell the domain to BME.

8 **C. The Infringing Domain Name <bme.com>**

9 39. <bme.com> was originally registered by an unknown party, who used it in a
10 non-infringing manner.

11 40. Motherboards.com became the registered name holder on or about
12 December 27, 2003.

13 41. Covanta Corp., a Wyoming Corporation, became the registered name holder
14 on or about June 7, 2005.

15 42. The domain was registered by Moniker Privacy Services on or about August
16 30, 2005.

17 43. On or about May 9, 2008, Mr. Ricks alter-ego, Gee Whiz, became the
18 registered name holder.

19 44. The Infringing Domain Names incorporate the entirety of the BME mark.

20 45. BME is informed and believes, and on that basis alleges that Ricks was
21 aware of BME's rights in the BME mark and willfully infringed upon it by registering the
22 Infringing Domain Name.

23 46. BME is informed and believes, and on that basis alleges that Ricks was
24 aware of BME's rights in the BME mark and willfully infringed upon it by using the Infringing
25 Domain Name in a bad faith attempt to capitalize on the BME mark by launching a web
26 page that dealt solely with tattooing, piercing, and body art.

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1 47. Ricks provided no *bona fide* services at <bme.com> or at <bme.us,> but
2 rather sent visitors into a rabbit hole of links that eventually leads to other websites. Ricks
3 then received payment for each of these clicks.

4 48. A copy of the website located at <bme.com> on May 10, 2008, is attached as
5 Exhibit L.

6 49. Upon information and belief, Ricks received financial consideration for this
7 mis-directed traffic.

8 50. Upon information and belief, Ricks intended to misdirect valuable Internet
9 traffic that otherwise would have gone to the BME Websites.

10 51. Upon information and belief, Ricks willfully created a likelihood of confusion
11 between BME's services and Ricks' services offered in connection with the Infringing
12 Domain Names.

13 52. Even if Ricks' conduct was not willful, his conduct still created a likelihood of
14 confusion between BME's services and Ricks' services offered in connection with the
15 Infringing Domain Name.

16 53. BME never consented to Ricks' use of the BME tradename, service mark,
17 and/or domain name, nor has BME sponsored, endorsed, nor approved of the services
18 offered and promoted by Ricks.

19 54. Ricks' services consist of nothing more than a misleading webpage
20 containing links to other webpages where goods and services pertaining to body piercing
21 and tattooing are located, along with images that lead the consumer to believe that the
22 webpage is sponsored by or provided by BME.

23 55. Ricks has done nothing to market or promote the BME mark independently of
24 the infringing services offered at <bme.com> and <bme.us,>

25 56. Upon information and belief, Ricks adopted and used the BME mark and the
26 Infringing Domain Name for the purpose of misleading and confusing the public about its
27 association with BME, and trading on the goodwill, reputation, and fame of BME and its
28 BME mark.

1 57. After learning of Ricks' use of the Infringing Domain Name, and the BME
 2 trade name and service mark, BME communicated with Ricks through its registrar,
 3 Moniker.com, to inquire as to Ricks' intentions.

4 58. Ricks demanded an exorbitant amount in exchange for the domain name.
 5 However, BME agreed to pay it. Upon acceptance of the offer, Ricks revoked the offer and
 6 increased the price twice as ransom for the Infringing Domain Name and the steady flow of
 7 stolen traffic and customers. This amount is well in excess of Ricks' reasonable expenses
 8 incurred in connection with the domain name.

9 59. Ricks' infringing conduct and refusal to respect BME's trademark rights
 10 indicates that Ricks deliberately and willfully selected and is using a mark and a domain
 11 name similar to BME's famous trademark to mislead and confuse consumers into believing
 12 that Ricks' website is provided by, sponsored by, or approved of by BME. Ricks is trading
 13 on BME's reputation and goodwill, and its enormous investment in the promotion of the
 14 BME service mark, thus diluting the distinctive quality of the famous BME mark.

15 60. Upon information and belief, Ricks knew about BME, the BME mark, and
 16 BME's business at the time he adopted the BME tradename, service mark, and domain
 17 name, and began offering his closely-related services under the BME mark.

18 61. Ricks' first commercial use of the BME mark and BME.com domain name
 19 occurred many years after BME's first use of the BME mark in connection with its services,
 20 and years after BME's common law rights had been established.

21 62. Ricks' first commercial use of the BME mark and the <bme.com> domain
 22 name occurred after BME's BME mark had become famous.

23 63. Ricks' <bme.com> domain name incorporates BME's trademark in its entirety.

24 64. Ricks uses the Infringing Domain Name in connection with services that are
 25 closely related to services offered in connection with BME's BME mark.

26 65. Ricks' promotion of his services under the <bme.com> domain name is
 27 directed at consumers of BME's services and is conducted through the same channels of
 28 trade as are used by BME to promote its services under the BME mark.

66. Ricks' use of the Infringing Domain Names, and Ricks' actions described herein are certain or likely to cause confusion, deception, and/or mistake as to: (a) the source or origin of Ricks' services; and (b) whether BME sponsors, endorses, or approves of Ricks or his services or is otherwise affiliated with Ricks.

67. Ricks' use of the Infringing Domain Names and Ricks' actions described herein dilute the distinctive quality of BME's famous BME mark.

68. Ricks' use of the Infringing Domain Names and Ricks' actions described herein have been, and continue to be deliberate, willful, and with disregard of BME's rights.

69. Ricks' continuing conduct constitutes an ongoing risk that the public will be confused as to the source or origin of the services provided at bme.com and bme.us.

70. BME has sustained, and will continue to sustain, irreparable injury as a result of Ricks' conduct. This injury is not compensable solely by the award of monetary damages. Unless Ricks is immediately restrained and enjoined from engaging in its infringing and diluting conduct, BME will continue to suffer irreparable injury.

FIRST CLAIM FOR RELIEF

Cybersquatting – 15 U.S.C. § 1125(d)

71. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-70, inclusive, as though set forth in their entirety herein.

72. This is an action under the ACPA, 15 U.S.C. § 1125(d).

73. Ricks' Infringing Domain Names are confusingly similar to and/or dilutive of BME's famous BME mark.

74. Ricks has registered, has used, and/or is using two Infringing Domain Names with the bad faith intent to profit from BME's famous BME mark.

75. Ricks' actions constitute a violation of the Lanham Act and the ACPA as codified at 15 U.S.C. § 1125(d).

76. BME has been, is now, and will continue to be irreparably harmed by Ricks' aforementioned acts, and unless enjoined by the Court, Ricks' unauthorized use of the

1 <bme.com> and <bme.us> Infringing Domain Names will continue, and there is no
 2 adequate remedy at law for the harm caused by the acts alleged herein.

3 **SECOND CLAIM FOR RELIEF**

4 **Trademark Infringement under 15 U.S.C. § 1125(a)**

5 77. BME incorporates by reference and realleges the allegations set forth in
 6 paragraphs 1-70, inclusive, as though set forth in their entirety herein.

7 78. This is an action for trademark infringement, pursuant to 15 U.S.C. § 1125(a).

8 79. BME alleges and believes that Ricks chose the <bme.com> and <bme.us>
 9 domain names, adopted the BME mark, and took the other actions alleged above, in order
 10 to cause confusion or mistake, to deceive the public as to the origin, sponsorship, or
 11 approval of his services, and/or to deliberately pass off his services as those of BME.

12 80. Ricks' conduct constitutes trademark infringement in violation of 15 U.S.C. §
 13 1125(a).

14 81. Unless enjoined, Ricks will continue his infringing conduct.

15 82. As a direct and proximate result of Ricks' infringing conduct, BME has
 16 suffered and will continue to suffer irreparable injury to its business reputation and goodwill
 17 for which no adequate remedy exists at law, and BME has lost sales, visitors and profits in
 18 an amount not yet fully ascertained.

19 83. Ricks conduct complained-of herein is malicious, fraudulent, knowing, willful,
 20 and deliberate, entitling BME to an accounting of Ricks' profits, increased damages, and an
 21 award of it's attorneys fees and costs incurred in prosecuting this action under 15 U.S.C. §
 22 1117.

23 **THIRD CLAIM FOR RELIEF**

24 **Willful Trademark Infringement under 15 U.S.C. § 1114(1)**

25 84. BME incorporates by reference and realleges the allegations set forth in
 26 paragraphs 1-70, inclusive, as though set forth in their entirety herein.

27 85. This is an action for declaratory and injunctive relief and damages pursuant to
 28 15 U.S.C. § 1114(1).

1 86. In the course of its conduct of business, BME's BME mark has been
 2 continuously used in association with the BME Websites. During this period, the BME mark
 3 and the BME reputation have continuously grown throughout the United States and
 4 worldwide as a source of origin for BME's services.

5 87. BME's mark has become associated in the minds of consumers with one of
 6 the most reputable tattoo and body piercing-related websites on the Internet, and BME
 7 enjoys the benefit of the ever-increasing fame and goodwill associated with the BME mark,
 8 as a result of its efforts and industry.

9 88. Ricks' aforementioned acts constitute willful infringement of BME's BME mark
 10 in violation of the Lanham Act, Section 32(1), 15 U.S.C. § 1114(1).

11 89. Consumers are likely to be confused by Ricks' use and display of the BME
 12 mark as a component of his URL.

13 90. Consumers who navigate to **<bme.com>** and **<bme.us>** are likely to believe
 14 that they are navigating to a site owned or endorsed by BME, thereby falsely designating
 15 the origin of the goods and services offered via the infringing site.

16 91. Consumers, once so misled, are likely to purchase goods and services at the
 17 sites **<bme.com>** and **<bme.us,>** believing they are BME's or somehow affiliated with BME,
 18 thereby resulting in a loss of sales to BME, blurring of the source of origin of products and
 19 services, and diluting the value of BME's marks.

20 92. The use by Ricks of the BME mark in connection with the Infringing Domain
 21 Names is likely to cause confusion, mistake, and deception in the relevant marketplace as
 22 to the source of origin of online services delivered to the end user who accesses
 23 **<bme.com>** and **<bme.us,>** and will continue to do so unless enjoined by this Court.

24 93. By such wrongful acts Ricks has caused, and unless restrained by the Court,
 25 will continue to cause serious irreparable injury and damage to BME and to the goodwill
 26 associated with the BME mark, including diversion of customers, lost sales, and lost profits,
 27 blurring tarnishment and dilution of the BME mark.

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FOURTH CLAIM FOR RELIEF**False Designation of Origin**

3 94. BME incorporates by reference and realleges the allegations set forth in
 4 paragraphs 1-70, inclusive, as though set forth in their entirety herein.

5 95. This is an action for damages and injunctive and declaratory relief pursuant to
 6 15 U.S.C. § 1125(a).

7 96. Ricks' aforementioned acts constitute false designation of origin, false
 8 representation and false description in violation of the Lanham Act, Section 43(a), 15
 9 U.S.C. § 1125(a).

10 97. By such wrongful acts, Ricks has caused, and unless restrained by the Court,
 11 will continue to cause serious irreparable injury and damage to BME and to the goodwill
 12 associated with BME's BME mark, including diversion of customers, lost sales and lost
 13 profits.

14 98. By such wrongful acts, Ricks has caused, and unless restrained by the Court,
 15 will continue to cause injury to BME's trademark rights, and to cause serious irreparable
 16 injury and damage to BME and to the goodwill associated with the BME mark, including
 17 diversion of customers, lost sales, and lost profits.

FIFTH CLAIM FOR RELIEF**Unfair Competition**

20 99. BME incorporates by reference and realleges the allegations set forth in
 21 paragraphs 1-70, inclusive, as though set forth in their entirety herein.

22 100. Ricks' aforementioned acts constitute unfair competition under the common
 23 law and under 15 U.S.C. § 1125(a).

24 101. On information and belief, beginning on or about May 9, 2008, and continuing
 25 thereafter, Ricks, without the consent of BME, registered an Internet Domain Name that
 26 infringed on BME's trademark rights and diverted traffic from BME's online business by
 27 forwarding unwitting customers to other websites that are in direct competition with BME.

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1 102. Ricks' use of the BME mark is likely to confuse and mislead the public and to
 2 induce the mistaken belief that Ricks' websites <bme.com> and <bme.us> are associated
 3 with BME.

4 103. Ricks' use of the BME mark is likely to confuse and mislead the public and to
 5 induce the mistaken belief that Ricks' websites are endorsed or sponsored by BME.

6 104. Ricks' use of the BME mark is likely to confuse and mislead the public and to
 7 induce the mistaken belief that Ricks' website is in some way connected with BME.

8 105. This confusion is likely to influence the decision of members of the public as
 9 to whether to use the services found at the sites to which <bme.com> and <bme.us>
 10 resolve.

11 106. Ricks' use of the BME mark is likely to confuse and mislead the public and to
 12 induce the mistaken belief that <bme.com,> <bme.us,> and/or the websites that they
 13 resolve to are associated with BME.

14 107. Ricks' use of the BME mark is likely to confuse and mislead the public and to
 15 induce the mistaken belief that these websites are endorsed or sponsored by BME.

16 108. Ricks' use of the BME mark is likely to confuse and mislead the public and to
 17 induce the mistaken belief that these websites are in some way connected with BME.

18 109. This confusion is likely to influence the decision of members of the public as
 19 to whether to use the services provided at <bme.com> or <bme.us.>

20 110. The aforesaid acts of Ricks constitutes false designation of origin and false
 21 description and representation tending falsely to describe Ricks' website and services, all in
 22 violation of § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

23 111. With knowledge of the falsity of such designation of origin, such description,
 24 and such representation, Ricks has utilized the aforesaid domain names <bme.com> and
 25 <bme.us> in interstate commerce.

26 112. By reason of such false designation of origin and false description and
 27 representation tending falsely to describe the aforesaid goods and services, BME has

1 suffered and will continue to suffer substantial damage to its business in the form of
2 diversion of trade, loss of profits, loss of goodwill, and damage to reputation.

3 113. By reason of the aforesaid false designation of origin and false description
4 and representation as alleged above, Ricks is liable to BME for the actual damages
5 suffered by BME as a result of Ricks' acts and any additional profits earned by Ricks as a
6 result of said acts.

7 114. BME has been damaged by Ricks' aforementioned acts.

8 115. Unless restrained and enjoined, the aforesaid false designation of origin and
9 false description and representation tending to mislead consumers will cause BME
10 irreparable injury.

11 **SIXTH CLAIM FOR RELIEF**

12 **Nevada Common Law Trademark Infringement**

13 116. BME incorporates by reference and realleges the allegations set forth in
14 paragraphs 1-70, inclusive, as though set forth in their entirety herein.

15 117. By virtue of having used and continuing to use its trademark, BME has
16 acquired common law rights in the BME mark.

17 118. Ricks' use of a mark identical and/or confusingly similar to BME's trademark
18 infringes BME's common law rights in its BME mark, and this use is likely to cause
19 confusion, mistake, or deception among consumers, who will believe that Ricks' web site
20 and/or Internet domain name originates from, or is affiliated with, or endorsed by BME
21 when, in fact, it is not.

22 119. As a direct and proximate result of Ricks' infringement of BME's common law
23 trademark rights under Nevada and other common law, Plaintiff has suffered, and will
24 continue to suffer, monetary damages and irreparable injury to its business, reputation, and
25 goodwill.

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SEVENTH CLAIM FOR RELIEF

Deceptive Trade Practices under N.R.S. § 598.0915

120. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-70, inclusive, as though set forth in their entirety herein.

121. Upon information and belief, in the course of operating his website, Ricks knowingly made false representations as to affiliation, connection and/or association with BME by using a mark confusingly similar to BME's trademark and otherwise engaged in deceptive trade practices.

122. As the direct and proximate result of Ricks' conduct, BME has suffered, and will continue to suffer, monetary damages and irreparable injury to its business, reputation, and goodwill.

EIGHTH CLAIM FOR RELIEF

Intentional Interference with Prospective Economic Advantage

123. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-70, inclusive, as though set forth in their entirety herein.

124. Upon information and belief, at the time Ricks adopted and began using BME's name and mark and since that time, Ricks knew and has known that BME is in the business of providing various products, services, information and publications related to the body piercing and tattoo industry.

125. Upon information and belief, Ricks committed acts intended or designed to disrupt BME's prospective economic advantage arising from advertising and/or providing these products and services.

126. Ricks' actions have disrupted or are intended to disrupt BME's business by, among other things, diverting web users away from BME's various web sites.

127. Ricks has no legal right, privilege or justification for his conduct.

128. As a direct and proximate result of Ricks' intentional interference with BME's prospective economic advantage, BME has suffered, and will continue to suffer, monetary damages and irreparable injury.

129. Based on the intentional, willful and malicious nature of Ricks' actions, BME is entitled to recover exemplary damages and reasonable attorneys' fees and costs incurred in connection with this action.

NINTH CLAIM FOR RELIEF

Trademark Infringement under the Fla. Stat. § 495.131

130. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-70, inclusive, as though set forth in their entirety herein.

131. This is an action for damages and injunctive relief under the Florida
Trademark Act, § 495.131, *Fla. Stat.* (2007).

132. Ricks' aforementioned acts constitute trademark infringement under the Florida Trademark Act, § 495.131, *Fla. Stat.* (2007).

133. Consumers are likely to be confused by Ricks' use and display of the BME mark as a component of Ricks' URL.

134. Consumers who navigate to **<bme.com>** are likely to believe that they are navigating to a site owned or endorsed by BME, thereby falsely designating the origin of the goods and services offered via the infringing site.

TENTH CLAIM FOR RELIEF

Dilution Under the Fla. Stat. § 495.151

135. BME incorporates by reference and realleges the allegations set forth in paragraphs 1-70, inclusive, as though set forth in their entirety herein.

136. This is an action for trademark dilution, pursuant to the Florida Trademark Act, § 495.151.

137. BME owns and has used the term "BME" as a distinctive trade name, trademark, and service mark throughout the United States and the world. By reason of BME's longstanding and exclusive use of its distinctive BME mark in connection with online journalism pertaining to body piercing and tattooing, the widespread public identification of that mark with BME's products and services, and the commercial success of the BME

1 || branded services, the BME mark is exceedingly well-known and famous around the world,
2 || as well as within the state of Florida.

3 138. Ricks' unauthorized use of the BME mark in the <bme.com> domain name in
4 the state of Florida began after the BME mark had become famous in this state.

5 139. Ricks' unauthorized use of the BME mark, as a component of the <bme.com>
6 domain name is likely to dilute the distinctiveness and identity-evoking quality of the BME
7 mark and trademark in violation of *Fla. Stat. § 495.151*.

8 140. Ricks' wrongful acts of dilution are likely to cause, and/or have caused, and
9 are causing irreparable harm to BME for which there is no adequate remedy at law.

10 Pursuant to *Fla. Stat.* § 495.151, BME is entitled to injunctive relief enjoining and
11 restraining Ricks from engaging in any further acts of dilution.

PRAYER FOR RELIEF

WHEREFORE, DEFENDANT PRAYS FOR JUDGMENT AS FOLLOWS:

14 1. That Plaintiff take nothing by virtue of this action and that same be dismissed
15 with prejudice.

16 2. That Defendant be awarded its attorney's fees and costs incurred in the
17 defense of this action:

18 3. Such other and further relief as the Court may deem just and proper;

19 4. A preliminary and permanent injunction prohibiting Ricks, his respective
20 officers, agents, servants, employees and/or all persons acting in concert or participation
21 with them, or any of them, from: (1) using BME's trademark or confusingly similar variations
22 thereof, alone or in combination with any other letters, words, letter strings, phrases or
23 designs, in commerce or in connection with any business or for any other purpose
24 (including, but not limited to, on web sites and in domain names); and (2) registering,
25 owning, leasing, selling, or trafficking in any domain names containing BME's trademark or
26 confusingly similar variations thereof, alone or in combination with any other letters, words,
27 phrases or designs;

5. A preliminary and permanent injunction requiring the current domain name registrar to transfer the **bme.com** and **bme.us** Internet domain names to BME;
6. An award of compensatory, consequential, statutory, and punitive damages to BME in an amount to be determined at trial;
7. An award of interest, costs and attorneys' fees incurred by BME in prosecuting this action; and
8. All other relief to which BME is entitled.

DATED: April 21, 2009

~~GREENBERG TRAURIG, LLP~~

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CERTIFICATE OF SERVICE

Pursuant to Fed. R. Civ. P. 5(b), I hereby certify that on April 21, 2009, service of the foregoing **AMENDED COUNTERCLAIM FOR DAMAGES, INJUNCTIVE, AND DECLARATORY RELIEF** was made this date through the Court's CM/ECF electronic filing system to:

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